

REMARKS

This Amendment is filed concurrently with an RCE in response to a Final Office Action mailed on January 19, 2006 (hereafter referred to as "Office Action"). A response to the Office Action is due no later than April 19, 2006. Accordingly, this Amendment is being timely filed.

By this Amendment, applicants have amended claims 1, 12, 18, 21 and 60. Claims 1-24, 59 and 60 are currently pending in the present application. Applicants respectfully submits that no new matter is added to the present application by the amendments to the claims provided for herein.

Examiner Interview

Applicants thank the Examiner for the telephone Interview of March 27, 2006, and for preparing the interview summary. Applicants have amended the claims as discussed in the Interview to overcome the references used as the basis for the rejection in the Office Action. Favorable consideration is therefore requested for the pending claims in the present application.

Rejections Under 35 USC § 103(a)

In the Office Action, the Examiner has rejected claims 1-11, 18-20, 59 and 60 as being unpatentable over U.S. Patent Application Publication No. 2002/0077978 A1 to O'Leary et al. (hereafter referred to as "O'Leary") in view of U.S. Patent Application Publication No. 2002/0062342 A1 to Sidles (hereafter referred to as "Sidles").

Independent claim 1, as amended, recites, *inter alia*, communicating determination computer code to a shopper's computer. O'Leary fails to explicitly teach communicating computer code for determining if a merchant website is a supported website (see, Page 2 of the

Final Office Action), and Sidles makes supported website determinations at a proxy computer not at a user computer (see Sidles, page 5, paragraph 55 and page 6, paragraphs 61-64, a form fill proxy computer 400 references a dictionary database 1000 to determine whether a visited merchant site has rules stored in the dictionary, not a user computer). Therefore applicants submit that Sidles does not teach, describe or suggest communicating determination computer code to a shopper's computer, as recited in amended claim 1, nor does O'Leary cure that deficiency. Therefore, applicants submit that the rejection of claim 1, under 35 U.S.C. §103(a) is no longer tenable, and applicants respectfully request withdrawal of that rejection.

Dependant claims 2-11 and 59 depend either directly or indirectly from independent claim 1 and are consequently not unpatentable over O'Leary in view of Sidles, at least for the same reasons discussed above with respect to the rejection of claim 1.

Additionally, applicants note that the Examiner has taken Official Notice of the teaching of the combination of a pull-down menu with a shopping assistant button, as recited in claim 3. Applicants submit that while this combined is ubiquitous in today's software, this may not have been the case at the time of the earliest priority date for the present application. Therefore, applicants respectfully request that the Examiner identify a reference predating the priority date of the present application, which teaches a pull-down menu in a toolbar button and, which also comprises a suggestion to combine said pull-down menu with a shopping assistant button, as recited in claim 3. Otherwise, applicant respectfully request withdrawal of this rejection.

The Examiner has also taken Official Notice with respect to a shopping assistant button providing an indicator when a browser is navigated to a supported merchant website, as recited in

claim 9. Even if, *arguendo*, graying out menu items or changing the contrast of an icon was notoriously well known in the art at the time of the earliest priority date for the present application, neither O'Leary nor Sidles suggests the combination of an indicator and a shopping assistant button as recited in claim 9. See *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (Fed. Cir. 1998) ("the legal conclusion of obviousness requires that there be some suggestion, motivation or teaching in the prior art whereby the person of ordinary skill would have selected the components that the inventor selected and used them to make the new device"). In addition, applicants argue that the motivation to combine is not found within the nature of the problem to be solved since graying out menu items and changing the contrast of an icon are used in the art to show the unavailability of said menu items or icons, while the indicator as recited in claim 9, is an indication of availability of a supported merchant website. Therefore, applicants submit that claim 9 is not unpatentable for this additional reason.

Independent claim 18 has been amended to recite "communicating shopping assistant computer code to add a shopping assistant button to a toolbar of the Internet browser, the shopping assistant computer code operable to determine if a web site to which the Internet browser is caused to navigate is a supported merchant web site", and is therefore similarly to claim 1 not unpatentable over O'Leary in view of Sidles.

Dependant claims 19-20 depend directly from independent claim 18 and are consequently not unpatentable over O'Leary in view of Sidles, at least for the same reasons discussed above with respect to the rejection of claim 18.

Independent claim 60 has been amended to recite “determining at the computer if a web site to which the Internet browser is caused to navigate is a supported merchant web site” and is therefore similarly to claim 1 not unpatentable over O’Leary in view of Sidles.

Applicants thus respectfully submit that the invention recited by claims 1-11, 18-20, 59 and 60 are not rendered obvious by O’Leary in view of Sidles. Therefore, applicants respectfully submit that the Examiner’s rejection of claims 1-11, 18-20, 59 and 60 is no longer tenable, and respectfully requests withdrawal of those rejections.

The Examiner has rejected claims 12-14, 16, 17, 21, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over O’Leary in view of Sidles. Applicants respectfully traverse this rejection. Independent claim 12, recites, *inter alia*, computer code operable on a user computer for determining if a web site to which an Internet browser is caused to navigate is a supported merchant web site. Therefore, applicants submit that O’Leary fails to disclose all of the features of independent claim 12, at least for the same reasons discussed above with respect to the rejection of claim 1. Furthermore, Sidles fails to cure that deficiency at least for the same reasons discussed above. Therefore, applicants submit that independent claim 12 is not rendered obvious by the hypothetical combination of O’Leary and Sidles.

Independent claim 21 recites a method comprising, *inter alia*, communicating computer code to a user computer that “determines if a web site to which the Internet browser is caused to navigate is a supported merchant web site.” Therefore, applicants submit that similarly, O’Leary fails to disclose all of the features of independent claim 21, at least for the same reasons

discussed above with respect to the rejection of claim 1. Furthermore, Sidles fails to cure that deficiency at least for the same reasons discussed above. Therefore, applicants submit that independent claim 21 is not rendered obvious by the hypothetical combination of O'Leary and Sidles.

Dependant claims 13-14, 16-17 and 23-24 depend directly from claims 12 and 21. Accordingly, applicants submit that O'Leary fails to disclose all of the features of claims 13-14, 16-17 and 23-24, at least for the same reasons discussed above with respect to the rejection of claims 12 and 21. Furthermore, Sidles fails to cure that deficiency at least for the same reasons discussed above. Therefore, applicants submit that dependant claims 13-14, 16-17 and 23-24 are not rendered obvious by the hypothetical combination of O'Leary and Sidles.

The Examiner has rejected claims 15 and 22 under 35 U.S.C. §103(a) as being unpatentable over O'Leary in view of Sidles and in further view of "Band Objects". Applicants respectfully traverse this rejection. Dependant claims 15 and 22 depend directly from claims 12 and 21. Accordingly, applicants submit that O'Leary fails to disclose all of the features of claims 15 and 22, at least for the same reasons discussed above with respect to the rejection of claims 12 and 21. Furthermore, Sidles fails to cure that deficiency at least for the same reasons discussed above. Therefore, applicants submit that dependant claims 15 and 22 are not rendered obvious by the hypothetical combination of O'Leary, Sidles and "Band Objects".

Applicants thus respectfully submit that the invention recited by claims 12-14, 16, 17, 21, 23 and 24 are not rendered obvious by O'Leary in view of Sidles, and that the invention recited

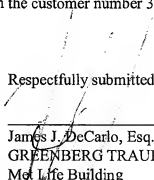
by claims 15 and 22 are not rendered obvious by O'Leary in view of Sidles and "Band Objects." Therefore, applicants respectfully submit that the Examiner's rejection of claims 12-14, 16, 17, 21, 23 and 24 as unpatentable over O'Leary in view of Sidles, and the rejection of claims 15 and 22 as unpatentable over O'Leary in view of Sidles and "Band Objects" are no longer tenable, and respectfully requests withdrawal of those rejections.

Conclusion

Applicants respectfully submit that claims in the present application (i.e., claims 1-24, 59 and 60) are now in condition for allowance, and respectfully requests reconsideration of the present application in view of the amendments to the claims, and in view of the remarks provided herein.

Early and favorable consideration of the present application is respectfully requested. If the Examiner is not in a position to allow all claims, the Examiner is urged to call the undersigned at 212-801-6729. Any additional fees or charges required at this time and in connection with the present application may be charged to Deposit Account No. 50-1561. All correspondence should continue to be mailed to the address associated with the customer number 32361.

Respectfully submitted,



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